

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-2, 4-7, 9-36 and 38-39 are presently active in this case. The present Amendment amends Claims 1, 6, 11, 18, 25 and 29 without introducing any new matter or raising new issues.

Claims 1, 2, 6, 7, 15, 22, 25-27, 29-31, 35, 38 and 39 were rejected under 35 U.S.C. §103(a) as unpatentable over Stefik et al. (U.S. Patent No. 6,233,684, herein "Stefik") in view of Hartrick et al. (U.S. Patent No. 5,532,920, herein "Hartrick") and Perlman (U.S. Patent No. 6,363,480). Claims 4-5, 9-10, 16-17, 23-24, 28 and 32 were rejected under 35 U.S.C. §103(a) as unpatentable over Stefik, Hartrick and Perlman in further view of Chou et al. (U.S. Patent No. 5,337,357, herein "Chou"). Claims 11-14 and 18-21 were rejected under 35 U.S.C. §103(a) as unpatentable over Stefik and Hartrick.

To clarify a minor formality, Claim 1 is amended to recite "a printing part configured to print the deciphered data on a recording medium after the judging part judges that the deciphered data is valid," and to recite "a processing part configured to update a version of the program used by the image forming apparatus based on the deciphered data after the judging part judges that the deciphered data is valid," to avoid conditional language in the claims. Independent Claims 6, 11, 18, 25 and 29 are amended to recite a similar feature. The changes find non-limiting support in Applicant's specification as originally filed, for example from page 21, line 24, to page 22, line 10, and therefore are not believed to raise a question on new matter.

In response to the remarks of the outstanding Office Action at page 2, lines 6-14, as not giving patentable weight to all the features of Applicant's claims, asserting that these features "merely describing intended use," Applicant respectfully traverses such an assertion,

and therefore requests reconsideration of the rejections under 35 U.S.C. §103(a), as next discussed.

In particular, regarding the feature “configured to,” it is believed that the terminology “configured to” clearly sets forth a structural limitation of the claimed element. For example, a processing part configured to update a version of the program *must* inherently be configured to update the version, and thereby defines the structural features of the image forming apparatus.

The specification clearly explains, as an example, that “in a case where the deciphered digital data and the like include data for updating software or updating versions of programs, ... the processor 131 can update the software stored in the storage unit 134 or update the version of the program,”¹ and therefore, the processing part of the image forming apparatus *must be* structurally arranged to update a version of the program, otherwise such update would not be possible.

Applicant believes that the outstanding Office Action is improperly extending the prohibition stated in MPEP §2111.04, “[c]laim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure.” In that regard, MPEP §2111.04 provides guidance that claim wording “adapted to” or “adapted for” fails to limit a claim to a particular structure. However, MPEP §2111.04 does not implicate the “configured to” as being improper. In this regard, Webster’s dictionary clearly defines both expressions in substantially different terms:²

configure:

To put together or arrange the parts of in a specific way or for a specific purpose; form into a configuration.

¹ See Applicants’ specification at page 22, lines 3-8.

² See the attached dictionary definitions, page 15, first column, and page 280, first column of Webster’s college dictionary, second revised edition, April 2000.

adapt:

To make suitable to requirements or conditions; adjust or modify fittingly.

Thus, from Webster's dictionary, "configured to" clearly sets forth a definite structural limitation, while the expression "adapted to" is essentially advisory in the sense of making something "suitable" for a particular requirement. Therefore, Applicant believes that the wording "configured to" clearly sets forth the structural distinction.

See also State Street Bank & Trust Co. v. Signature Financial Group Inc. 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Circ.1998), in which Judge Rich used the expression "configured to" in referring to structure disclosed in the specification of that patent in issue as corresponding to respective means-plus-function claim limitations. As used by Judge Rich, the references to "configured to" clearly connote structure.

The outstanding Office Action asserts that "claims directed to an apparatus must be distinguished from the prior art in terms of a structure alone" and "claims 1, 2, 4-7, 9, 10, 25-46 [sic], 38 and 39 depict structural elements in terms of functional language or 'intended use' (e.g. 'configured to', 'connectable') they are not distinct, in terms of patentability, from the prior art,"³ and thereby points out to the case In re Schreiber (128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Circ. 1997).

However, in the In re Schreiber case, it is not discussed whether the expression "configured to" sets forth a structural limitation for a claimed element, but discusses the patentability of mechanical dimensions of a conical dispenser over applied art, the mechanical dimensions set forth by a descriptive language of intended use of the conical dispenser for dispensing popcorn in a certain way, whereas the conical dispenser itself is well known in the art. Applicant respectfully submits that in Applicant's claims, no mechanical limitations are set forth by a descriptive language for an intended use, and that the structural

³ See the outstanding Office Action at page 2, lines 9-14.

limitations of Applicant's claims defined after the expression "configured to" are not a mere description of a "new intended use for old product," forming the base for upholding the Examiner's rejection in the In re Schreiber case.

The same rational is applicable for every element of Applicants' Claims 6, 25 and 29, that is configured by a specific structural limitation for performing a specific function. Therefore, it is believed that the specification supports the "configured to" language of Applicants' Claims 1, 6, 25 and 29 adds structural distinction to the claim language.

In response to the objection made by the outstanding Office Action on page 3, lines 5-10 regarding dependent Claims 2, 7, 12, and 19, Applicant respectfully submits that original claims form part of the original disclosure and provide their own written description, see also In re Anderson 471 F.2s 1237, 176 USPQ 331 (CCPA 1973), and therefore, Applicant respectfully requests withdrawal of this objection.

In light of the above comments, Applicant respectfully requests reconsideration of the rejections of Claims 1-2, 4-7, 9-36 and 38-39 under 35 U.S.C. §103(a), and traverses the rejections, as discussed next.

The applied reference Stefik describes a trusted rendering system for controlling the distribution and use of digital works. However, Stefik fails to teach a processing part configured to update a version of a program used by the image forming apparatus, as further confirmed by the outstanding Office Action. Stefik indeed explicitly teaches that a system for controlling the distribution and use of *printed digital works* is disclosed and that the system is able to add watermarks to printed digital works.⁴ A system for adding watermarks to printed digital works, as taught by Stefik, *is not* a processing part configured to update a version of the program used by the image forming apparatus, as recited in amended Claim 1.

⁴ See Stefik at column 3, lines 6-39 and in Figure 8.

The outstanding Office Action rejects Applicant's Claims 1, 2, 6, 7, 15, 22, 25-27, 29-31, 35 and 38-39 based on the proposition that Hartrick discloses a similar feature,⁵ and that it would have been obvious to modify Stefik by importing this feature from Hartrick to arrive at Applicant's claimed invention. Applicant respectfully submits, however, that Claim 1 is hereby amended to clarify this feature, and that Hartrick fails to disclose the above feature related to a processing part configured to update a version of the program used by the image forming apparatus, as next discussed.

The outstanding Office Action relies on Hartrick's text at column 5, lines 42-63 and on Hartrick's Figures 2, 8A-8B.⁶ Hartrick's column 5 suggests that if the user's copying of an electronic book fails before an entire book is downloaded, the downloading can be resumed at a later time. Regarding Hartrick's Figures 8A-8B, Hartrick explains that to read a book stored on the storage disk, the user applies a special softcopy book reading program 35,⁷ and also teaches that the softcopy book reading program 35 manages the royalty payments.⁸ Therefore, reading Hartrick, a person of ordinary skill in the art would understand that downloading missing parts of an electronic book, that will be viewed by a reading program, *is not* a processing part configured to update a version of the program used by the image forming apparatus.

The reference Perlman, relied upon by the outstanding Office Action to form the 35 U.S.C. §103(a) rejection, describes a system and method for a user to encrypt data in a way so that the data cannot be encrypted after a finite period.⁹ However, Perlman is also silent on the processing part configured to update a version of a program used by the image forming apparatus, based on the deciphered data, as claimed in amended independent Claim 1.

⁵ See the outstanding Office Action from page 5, lines 8-12.

⁶ See the outstanding Office Action from page 5, line 12

⁷ See Hartrick at column 11, lines 55-60 and in Figures 8-8A.

⁸ See Hartrick from column 14, line 51 to column 15, line 51-57 and in Figures 8-8A.

⁹ See Perlman in the Abstract.

Accordingly, even assuming that the combination of Stefik, Hartrick and Perlman is proper, the applied references fail to teach or suggest all the elements of Applicant's independent Claims. Accordingly, Applicant respectfully requests reconsideration of the rejection of Claims 1-2, 6-7, 15, 22, 25-27, 29-31, 35 and 38-39.

Independent Claims 6, 11, 18, 25 and 29 recite features analogous to the features recited in independent Claim 1. Moreover, Claims 6, 11, 18, 25 and 29 have been amended in a manner analogous to the amendment to Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicant respectfully submits that the rejections of Claims 6, 11, 18, 25 and 29, and all associated dependent claims, are also believed to be overcome in view of the arguments regarding independent Claim 1.

Further, the reference Chou applied in the context of a 35 U.S.C. §103(a) rejection of the dependent claims does not remedy the deficiencies of the references Stefik, Hartrick and/or Perlman, taken individually or in combination, as discussed above. Chou is concerned with a method for protecting distributed software, wherein a profile for an user is used to generate a key unique to the user.¹⁰ However, Chou fails to teach or suggest that a processing part is configured to update a version of the program used by the image forming apparatus, as explained above. Accordingly, Applicant respectfully requests reconsideration of these rejections under 35 U.S.C. §103(a).

The present amendment is submitted in accordance with the provisions of 37 C.F.R. § 1.116, which after Final Rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present amendment is believed to overcome outstanding rejections under 35 U.S.C. §103(a), the present amendment places the application in better form for consideration on appeal. In addition, the present amendment is not believed to raise new issues because the changes to Claims 1, 6, 11, 18, 25 and 29 are of a

¹⁰ See Chou in the Abstract and in Figure 1.

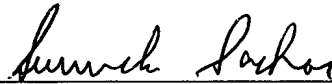
minor nature, and have been considered by the outstanding Office Action. It is therefore respectfully requested that 37 C.F.R. §1.116 be liberally construed, and that the present amendment be entered.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-2, 4-7, 9-36 and 38-39 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

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